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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,083	04/04/2001	Bruce Royer	57111-5094	3868

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JEFFER, MANGELS, BUTLER & MARMARO, LLP
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LOS ANGELES, CA 90067

EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,083

Applicant(s)

ROYER ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Request for Reconsideration

1. Applicant's submittal of a request for reconsideration was entered on 2/13/04, wherein: claims 1-48 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract ideas, laws of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

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In this case, claim 18 fails to recite the use of technology to perform the process. Claim 18 as originally filed can be performed manually. The Examiner recommends amending 18 to include language similar to claim 1, that includes the recitation of a network or computer.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 9-13, 15, 17-24, 26-30, 32, 34-37, 40-44, 46, and 48 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,892,905 (hereinafter “Brandt”).

Brandt discloses a system and method for accessing rental equipment reservation software applications via the world-wide web, including the steps of: displaying reservation summary having reservation data (i.e. car preference, origin city, etc.) and vehicle type information (see column 23, lines 64-67); tracking equipment inventory (see column 23, lines 30-40); making confirmation of reservation (see column 28, lines 60-63); updating reservation information (see column 32, lines 47-48); searching equipment inventory (see paragraph bridging columns 29-30); and displaying customer information and customer history information(see column 31, lines 7-11).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 9, 23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt in view of Internet Publication to Ryder (hereinafter "Ryder").

If it is held that fails to inherently disclose displaying route selection information selected from one-way and in-town, then Ryder is relied upon to teach one-way truck rental (see page 2, "Save 10% on All One-Way Rentals").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with the display of one-way or in-town route information as taught by Ryder, because it is important for vehicle inventory tracking to determine if a rental truck will be returned to the original vendor or a different vendor.

7. Claims 8, 25, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt in view of U.S. Patent No. 6,266,277 (hereinafter "Craig").

Brandt fails to expressly disclose alerting the user of upon the detection of an update failure.

Craig teaches the use of a system alerting the user of upon the detection of an update failure (see paragraph bridging columns 7-8).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with update alert failures as taught by Craig, because update alert failure notifications allows the user to determine when updates have problems.

8. Claims 14, 31, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt in view of U.S. Patent No. 6,085,976 (hereinafter "Sehr").

Brandt fails to expressly disclose displaying payment information.

Sehr teaches the use of displaying payment information (see column 16, lines 1-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with payment information display as taught by Sehr, because it is advantageous for vehicle rental vendors to know if a customers has paid for the rental before the customer leaves with the vehicle.

9. Claims 16, 33, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt in view of U.S. Patent No. 5,344,172 (hereinafter "Jaun").

Brandt fails to expressly disclose verifying compatibility between a requested towing combination.

Jaun teaches that different towing combinations have varying towing capacities (see column 1, lines 29-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brandt with verifying towing combinations as taught by Jaun, because improper towing combinations can damage the rental equipment and possibly cause physical harm to the users.

Response to Arguments

10. Applicant's arguments filed February 13, 2004 have been fully considered but they are not persuasive.

On page 2, final paragraph, Applicant submits that the Examiner has misapplied the law by equating the lack of computer hardware limitations in the claims at issue as an attempt to claim "abstract ideas". Additionally, on page 3, Applicant cites *AT&T Corp. v. Excel Communications*, 172 F.3d 1352, 1357 (Fed. Cir. 1999) in an attempt to clarify that Applicant's invention is "useful." It is the Examiner position that claims 18-34 fail to meet requirements of 35 U.S.C. § 101 because the claims fails to recite limitations that apply, use, or advance the technological arts. The term "technological arts" is synonymous with the phrase "useful arts" as it appears in Article I, Section 8 of the Constitution. *In re Waldbaum*, 173 USPQ 430 (CCPA 1972). For a claim to be statutory, it must be in the technological arts. *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974). The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001)(Unpublished). Also note MPEO 2106 IV 2(b). Although Bowman is not precedential, Bowman is cited for its analysis of whether the claims are in the technological arts. In regards to AT&T, technology is cited in the claims as set forth below in claim 1:

1. A method for use in a **telecommunications system** in which interexchange calls initiated by each subscriber are automatically routed over the **facilities** of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of: generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said

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message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. (emphasis added).

In the current application, claims 18-34 may be practiced manually, for example, with pencil and paper. As set forth above and in the first office action, Applicant may overcome the current rejection by adding limitations positively claiming a computer or network (see claim 1 of current invention).

On page 4, Applicant notes the current invention was conceived and reduced to practice prior to June 14, 2000 (the earliest effective filing date of US Publication 2002/0099613 to Swart). Applicant's 1.131 declaration has been considered and the 35 U.S.C. § 102 (e) rejection as anticipated by Swart is withdrawn.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

Application/Control Number: 09/826,083

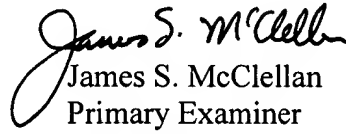
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or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
April 23, 2004